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In re Application of
GRUSS, et al.
Application No.: 10/088,657
PCT No.: PCT/FR00/02611
Int. Filing Date: 20 September 2000
Priority Date: 20 September 1999
Attorney Docket No.: 045636-5056-US
For: LACTIC ACID BACTERIA TRANSFORMED
TO BE PROVIDED WITH RESPIRATORY
METABOLISM

DECISION ON REQUEST

UNDER 37 CFR 1.42

This is a decision on applicant's "Response to Notification of Missing Requirements Under 35 U.S.C. § 371 in The U.S. Designated/Elected Office (DO/EO/US)" filed in United States Patent and Trademark Office (USPTO) on 21 October 2002, which is being treated as a request for acknowledgment of status under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 20 September 2000, applicant filed international application PCT/FR00/02611, which claimed priority of an earlier application filed 20 September 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 29 March 2001. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 March 2002.

On 20 March 2002, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee. No oath or declaration of the inventors was included.

On 21 May 2002, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date as well as an English translation of the international application. Applicant was further informed of the need to provide payment of the surcharge for providing the oath or declaration later than

thirty months from the priority date as well as the processing fee for providing an English translation of the international application later than thirty months from the priority date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 21 October 2002, applicant filed the present response which included authorization to charge Deposit Account No.: 50-0310 \$1180.00 (\$130.00 surcharge for providing an oath or declaration later than thirty months from the priority date, \$130.00 processing fee for providing an English translation of the international application later than thirty months from the priority date and \$920.00 as payment for a three-month extension of time); a petition for a three-month extension of time and a declaration/power of attorney executed by joint inventors Alexandra GRUSS, Yves Le LOIR and Philippe GAUDU as well as Charlotte DUWAT and Coralie DUWAT as heiresses of the deceased joint inventor Patrick DUWAT.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration filed 21 October 2002 was executed by Charlotte DUWAT and Coralie DUWAT as heiresses of the deceased joint inventor Patrick DUWAT. However, the declaration is not in compliance with 37 CFR 1.497 (a)-(b) in that it is unclear whether the declaration is setting forth the residence, post office address and country of citizenship of the deceased joint inventor Patrick DUWAT or the heiresses. 37 CFR 1.497(b) requires that the information be provided for both the deceased joint inventor Patrick DUWAT and both the surviving heiresses. In addition, neither the declaration nor the transmittal letter declares that Charlotte DUWAT and Coralie DUWAT constitute all the heirs of the deceased. Thus, there may be other heirs who are required to sign the declaration. Applicant is required to file a statement either from the heiresses themselves or applicant's counsel setting forth that the individuals listed above represent all of the heirs of the deceased inventor, Patrick DUWAT. In addition, said statement should set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Petition Under 37 CFR 1.42." No petition fee is required.

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Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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